

**Notice of Allowability**

Application No.

10/054,462

Applicant(s)

SCALONE ET AL.

Examiner

Rebecca L Anderson

Art Unit

1626

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed 26 January 2004.
2. ☒ The allowed claim(s) is/are 1 and 3-31, now renumbered 1-30.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)           |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment                              |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance  |
|   | 9. <input type="checkbox"/> Other _____   |

### **DETAILED ACTION**

Claims 1, 3-31 are currently pending in the instant application, appear allowable over the prior art of record and are renumbered as claims 1-30.

#### ***Response to Amendment***

Applicants amendment filed 26 January 2004 has cancelled claims 2, 32 and 33 without prejudice to filing in a continuing patent application that claims the benefit of the subject application's filing date under 35 USC 120. The amendment has also amended claims 1 which has overcome the objection to claims 1 and 3-31 for containing non-elected subject matter. The amendment to claim 15 has overcome the minor informality objection.

#### ***Reasons for Allowance***

The following is an examiner's statement of reasons for allowance. This invention relates to a process for preparing a compound of the formula (I) wherein X is N-Z which comprises cyclocarbonylating a compound of the formula (II) wherein X is N-Z. The novel and nonobvious aspect of this invention is the cyclocarbonylation of the compound of the formula (II) wherein X is N-Z to prepare the compound of the formula (I) wherein X is N-Z. The closest prior art of record is US Patent No. 6,291,685 discloses the process for the preparation of hydroxybenzothiophene of formula (I) (column 17, line 35) comprising the cyclocarbonylation of a compound of formula (II) (column 17, line 45) to form the carbocyclic acid ester of the compound of the formula I and thereafter saponifying said ester product to form the hydroxybenzothiophene of formula I (column 17, lines 30-67).

Therefore, in view of the diversity among reactivity of thienyl, furanyl and pyrrolyl material, a restriction among the processes was made. Applicants' have cancelled the processes where X is oxygen and sulfur. While the starting material of the formula (II) with X as sulfur has been made available in US Patent No. 6,291,685, the starting material of the formula (II) with X as N-Z is novel and unobvious.

According to *In re Ochiai* (CAFC) 37 USPQ2d 1127 (1995): A process is considered novel when the process invention recited in the claim specifically requires use of a new and unobvious starting material and when it would not have been obvious to those of ordinary skill in the art to choose the particular starting material required by the claim, which was unknown in the prior art. The characterization of specifically claimed starting materials as "similar" to or "slightly different" from those used in prior art cannot establish obviousness of use of starting material that is new and nonobvious, both in general and in claimed processes.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

Art Unit: 1626

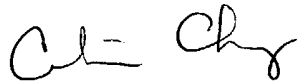
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (571) 272-0699.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier number for accessing the facsimile machine is (703) 872-9306



Rebecca Anderson  
Patent Examiner  
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for

Joseph McKane  
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Art Unit 1626, Group 1620  
Technology Center 1600